

DETAILED ACTION

Applicants' amendment filed 6-12-09 has been received and entered. Currently, claims 1-9 are pending and under consideration for examination. Claims 1, 6, and 9 are under currently amended and claim 9 is new.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Osumi et al Japanese publication (JP20033055184) in view of Deckner et al (US 5,968,528) for reasons of record and restated below:

The claims are drawn to a skin lightening composition, comprising 0.1-50% by weight of extracts of plants from the genera *Symplocos* and *Rubia*; the extract of *Symplocos* being selected from *Symplocos recemosa*, *Symplocos paniculata*, *Symplocos cochinchinesis*, or mixtures thereof; the extract of *Rubia* being *Rubia cordifolia*.

The reference of Osumi et al beneficially teaches a skin care composition with bleaching (i.e. whitening) action comprising an extract from the plant *Symplocos racemosa*. The extracts from *Symplocos* can be extracted from the bark or other parts of the plant. The extracts from *Symplocos* have excellent active oxygen scavenging

activity, collagenase inhibitory and tyrosinase inhibitory actions. The skin care composition has excellent aging preventing actions and good stability (see abstract, and pages 1-3, e.g.).

The reference of Deckner et al. beneficially teaches a skin care composition to treat the signs of aging. The composition comprising vitamin B3, especially niacinamide and can also comprise of other dermatological active ingredients such as extracts from the plants of the genus *Rubia*, particularly *Rubia Cordifolia*, sunscreen agents such as 2-ethyl hexyl methoxycinnamate, skin lightening agents, and glycyrrhiza (licorice) (columns 28, lines 14-44; 29, lines 57-6; 31, lines 41-60, e.g.).

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to combine the instant ingredients for their known benefit since each is well known in the art for the same purpose (e.g., in skin compositions for skin conditioning) and for the following reasons. It is well known that it is *prima facie* obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. In *re Kerkhoven*, 626 F.2d 846, 850, 205 U.S.P.Q. 1069 (CCPA 1980), In *re Sussman*, 1943 C.D. 518; In *re Pinten*, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); In *re Susi*, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); In *re Crockett*, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960).

This rejection is based on the well established proposition of patent law that no invention resides in combining old ingredients of known properties where the results obtained thereby are no more than the additive effect of the ingredients. With respect to the percent by weight of the claimed ingredients in the instant composition is viewed as judicious selection and adjustments of particular working conditions that are within the purview of one skilled in the art.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Response to Arguments

Applicant's arguments filed 6-19-09 have been fully considered but they are not persuasive:

Applicant argues that the '184' reference fails in every way to specifically describe all of the specific *Symplocos* extracts set forth in the claimed invention. Applicant argues that the reference of '184' is deficient in that it fails to describe the extract of *Rubia* used in conjunction with *Symplocos* extract. Applicant argues that the examiner has relied on the '528' reference to correct the deficiencies but there is not teachings in either reference '184' or '528' that they will yield excellent skin lightening

benefits. These arguments have been fully considered but not found to be persuasive of error.

In response, the claims do not require that the examiner apply art describing all of the species of *Symplocos* because the claim is in a markush format and therefore at least one species will meet the limitation of the instant claims. With respect to the references of '184' and '528' not teaching skin lightening benefits, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicant argues that there is no teaching of synergistic benefits the inventors have observed when using a mixture of the extracts of *Rubia* and *Symplocos*. The applicant's have directed the examiner's attention to the specification, Table 1 and Table 2. These arguments have been fully considered but not found to be persuasive of error.

In response, although applicant has claimed synergistic results of the two extracts of *Rubia* and *Symplocos*, the amounts of each to acquire such synergism is not clear. It is not clear if the range of 0.1 - 50% is for one or both abstracts. Further, it is obvious to one of ordinary skill in the art to combine two compositions useful for the same purpose in order to form a third composition, *In re Kerkhoven*. Both compositions are useful for conditioning of the skin to treat signs of aging. Therefore, the combination of the '184' and the '528' references are obvious over the claimed invention.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBORAH A. DAVIS whose telephone number is (571)272-0818. The examiner can normally be reached on 8-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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